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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,838	11/21/2000	Walter D. Gillespie	18608002410	2083

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NU VASIVE, INC.
10065 OLD GROVE ROAD
SAN DIEGO, CA 92131

EXAMINER

WINGOOD, PAMELA LYNN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/717,838

Applicant(s)
Gillespie et al.

Examiner
Pamela Wingood

Art Unit
3736



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8.5.02
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 17 is/are rejected.
- 7) ☒ Claim(s) 4-10 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1, and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Cesarini et al.

Cesarini et al. shows (Fig. 5) an outer tubular member (20) having a flexible region (28) with cylindrical cutting bit member (15 at Fig. 2) mounted at its distal end, with the cutting member having a plurality of serrated teeth (Col. 3, lns. 60-65). All of the elements of the claims are anticipated by the reference; hence it was used although the function recited in the preamble "a bone graft harvesting drill" is not present. So long as the reference is capable of deflecting off cortical bone tissue because of the flexible region, it anticipates the claims.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Trott (208).

Trott (208) discloses a device for cutting at 26 (Col. 4, lns. 10-14) having a plurality of teeth and flexible tubular member capable of being bent (Col. 4, lns. 29-35). All of the elements of the claims are anticipated by the reference; hence it was used although the function recited in the

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preamble "a bone graft harvesting drill" is not present. So long as the reference is capable of deflecting off cortical bone tissue because of the flexible region, it anticipates the claims.

4. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Del Rio et al..

Del Rio et al. discloses a bit for cutting bone having a cylindrical shape, a beveled outer periphery (Col. 6, lns. 9-45) that deflects off bone (Col. 6, lns. 20-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cesarini et al. in view of Durgin et al.

Cesarini et al. discloses the limitations above but does not disclose the use of a semi-rigid thermoplastic material for the tubular member.

Durgin et al. discloses a sheath of a semi-rigid thermoplastic material in an analogous art for the purpose of enabling it to be folded. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Cesarini et al. as shown by Durgin et al. because the use of such a material for the tubular member would enable it to be easily navigated through the vasculature to the bone (Col. 4, lns. 19-23).

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Allowable Subject Matter

7. Claims 11-16 and 18 are allowed. The following is a statement of reasons for the indication of allowable subject matter: Prior art does not suggest or disclose a method for harvesting bone graft material comprising inserting a distal end of a hollow cylindrical drill into the patient's ilium, the distal end of the hollow cylindrical drill comprising a flexible tubular member.

8. Claims 4-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: In Claim 4, prior art does not suggest or disclose a drill bit having a plurality of teeth with the outer surfaces of the teeth facing inward toward the distal ends. In Claim 7, prior art does not suggest or disclose a drill bit comprising at least one projection facing inwardly into the bore of the drill bit.

Response to Arguments

9. Applicant's arguments filed on 8.5.02 have been fully considered but they are not persuasive. The Examiner strongly believes that the rejections to claims 1-3 and newly filed claim 17 are valid. Regarding claims 1-3, so long as the reference is capable of performing the claimed function it anticipates the claimed invention. Here the flexible portion would enable the device to deflect off the outer bone.

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Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any questions related to this application can be addressed to Pamela Wingood who can be reached on (703) 308-2676 on Monday - Friday from 8:00-5:30PM.


Pamela Wingood

Patent Examiner

October 20, 2002


MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700